

Applicants' previous Amendment dated 12/6/04 and for the additional reasons discussed below.

Claims 12-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weinberger '027 in view of Lafreniere, U.S. Patent No. 4,821,118 (hereinafter "Lafreniere '118"). Applicants believe that these claims are allowable over the cited references for the reasons discussed in Applicants' previous Amendment dated 12/6/04.

Claims 21-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weinberger '027 in view of Clemens '723 and Lafreniere '118 and further in view of Pugliese '353. Applicants believe that these claims are allowable over the cited references for the reasons discussed in Applicants' previous Amendment dated 12/6/04 and for the additional reasons discussed below.

#### **Legal Standard for Claim Rejection Under 35 U.S.C. §103**

The test for obviousness under 35 U.S.C. §103 is whether the claimed invention would have been obvious to those skilled in the art in light of the knowledge made available by the references. *In re Donovan*, 184 USPQ 414, 420, n. 3 (CCPA 1975). It requires consideration of the entirety of the disclosures of the references. *In re Rinehart*, 189 USPQ 143, 146 (CCPA 1976). All limitations of the claims must be considered. *In re Boe*, 184 USPQ 38, 40 (CCPA 1974). In making a determination as to obviousness, the references must be read without benefit of Applicants' teachings. *In re Meng*, 181 USPQ 94, 97 (CCPA 1974). In addition, the propriety of a §103 rejection is to be determined by whether the reference teachings appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination, or other

modifications. *In re Lintner*, 173 USPQ 560, 562 (CCPA 1972). A reference which teaches away from the Applicants' invention may not properly be used in framing a 35 U.S.C. §103 rejection of Applicants' claims. See *United States v. Adams*, 148 USPQ 479, 484 (1966).

A basic mandate inherent in §103 is that a piecemeal reconstruction of prior art patents shall not be the basis for a holding of obviousness. It is impermissible within the framework of §103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *In re Kamm*, 172 USPQ 298, 301-302 (CCPA 1972).

When determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Ecolchem Inc. v. Southern California Edison*, 56 USPQ2d 1065, 1073 (Fed. Cir. 2000). In other words, there must be something in the teachings of cited references to suggest to an individual skilled in the art that a claimed invention would be obvious. *W. L. Gore and Associates v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1983). This position was reaffirmed in the case of *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 43 USPQ 2d 1294 (Fed. Cir. 1997). *Arkie Lures* involved the combination of a plastic fishing lure with salt materials to yield a highly attractive lure product. The prior art disclosed both concepts (salty bait and plastic lures) separately but not in combination. The CAFC ultimately held that the invention under consideration was not obvious. Even though both of the claimed features were disclosed by the cited art, the CAFC concluded that this was insufficient to

prove a case of obviousness in the absence of a teaching or suggestion in the art to combine the references.

Likewise, the requirement that a **concrete suggestion** be present in the cited art for a proper obviousness rejection to be made is even further supported by *C.R. Bard Inc. v. M3 Systems Inc.*, 48 USPQ 2d 1225 (Fed. Cir. 1998). This case involved an allegation that a particular medical needle apparatus was merely a product of "obvious modifications" to a prior needle assembly. The CAFC disagreed and stated that the claimed invention was neither suggested nor taught by the prior art, and further indicated that the "invention that was made, however, does not make itself obvious; **that suggestion or teaching must come from the prior art**" itself. 48 USPQ 2d at 1232 (emphasis added). The CAFC also concluded that the requisite suggestion or teaching was so important that, in its absence, the claimed invention could not have been obvious. According to the court, "Absent this essential evidentiary component of an obviousness holding, as a matter of law the verdicts of invalidity on that ground cannot stand. Consequently, the judgment of invalidity based on obviousness is reversed." 48 USPQ 2d at 1232.

#### **Rejection of Claims 1-11**

As noted above, claims 1-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weinberger '027 in view of Clemens '723 and further in view of Pugliese '353. Applicants believe that these claims are allowable over the cited references for the reasons discussed in Applicants' previous Amendment dated 12/6/04, as well as for the following reasons. Applicants' arguments in the previous Amendment regarding the allowability of claims 1-11 over Weinberger '027 in view of Clemens '723 are herein renewed.

Pugliese '353 is directed to a baggage check-in and security system and method. A video camera (130) may be provided to record a picture of each bag as it is checked so that a digital image may be stored in the passenger record to aid in finding lost bags.

On page 3 of the Office Action, the Examiner states that "Weinberger and [Clemens] do not disclose image data 'is stored on a digital camera memory device'. However, this is obvious and very well known in the art, as evidenced by Pugliese (col. 4, lines 48-52)." Applicants respectfully traverse. While image data stored on a digital camera memory device **by itself** may be "very well known in the art", **this element when combined with the other elements of Applicants' claim 1 is unique and non-obvious.** More specifically, a communications system having a plurality of communications units fixedly mounted onboard an airplane, wherein each of the communications units comprises at least one receiver adapted to receive image data that is stored on a digital camera memory device and input by an associated passenger and display the image data on a video screen [Applicants' claim 1, element a] is not "very well known in the art", nor is it disclosed by Pugliese '353. The evidence to which the Examiner refers in Pugliese '353 reads as follows:

...It is also possible to provide a digital camera in the machine to take a picture of each bag, to be stored in the passenger record as graphic data, for later use in finding and identifying lost bags.

In column 12, on lines 57-60, Pugliese '353 further explains that the "digital camera" may be a video camera (130) that records a picture of each bag as it is checked, so that a digital image may be stored in the passenger record to aid in finding lost bags. Unlike Applicants' communications units, the video camera (130) of Pugliese '353 is not "fixedly mounted onboard an airplane." Furthermore, Pugliese '353 adds nothing to the deficiencies of Weinberger '027 and Clemens '723 discussed above.

On page 3 of the Office Action, the Examiner states that "it would have been obvious... to improve upon the security system, as disclosed by Pugliese. Doing so would provide a security system, which allows a passenger to check-in his or her own baggage without the assistance of airline terminal [sic]." Since Applicants are not claiming a security system or a baggage check-in system, it is unclear what the Examiner is saying about Applicants' invention. It appears that the Examiner is stating that Pugliese '353 is obvious in view of itself. Applicants request clarification of this statement and also an explanation from the Examiner as to what, if anything, Pugliese '353 adds to the deficiencies of Weinberger '027 and Clemens '723 which are discussed above and noted by the Examiner in the Office Action.

For at least the above reasons, Applicants' claim 1 is believed to be allowable over the cited references. Claims 2-11, which are each directly or ultimately dependent on claim 1, are believed to be allowable as depending from an allowable base claim, and also because of the novel and nonobvious combination of elements disclosed therein.

#### **Rejection of Claims 12-20**

As noted above, claims 12-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weinberger '027 in view of Lafreniere, U.S. Patent No. 4,821,118 (hereinafter "Lafreniere '118"). Applicants believe that these claims are allowable over the cited references for the reasons discussed in Applicants' previous Amendment dated 12/6/04. Applicants' arguments in the previous Amendment regarding the allowability of claims 12-20 over Weinberger '027 in view of Lafreniere '118 are herein renewed.

**Rejection of Claims 21-22**

As noted above, claims 21-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weinberger '027 in view of Clemens '723 and Lafreniere '118, and further in view of Pugliese '353. Applicants believe that these claims are allowable over the cited references for the same reasons as claims 1 and 12 that are discussed above and in Applicants' previous Amendment dated 12/6/04. These arguments are herein renewed.

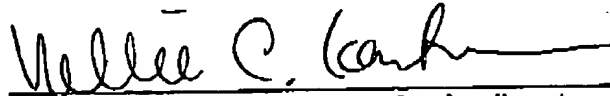
**Conclusion**

For at least the reasons discussed above, Applicants believe that all of the pending claims (claims 1-22) are allowable over the cited references. Therefore, Applicants respectfully request that the Examiner reconsider the application and grant an early allowance or, alternatively, issue an Advisory Action so that Applicants may timely file a Notice of Appeal.

Should there be any questions regarding this Response, the Examiner may contact Applicants' attorney at the telephone number listed below.

Respectfully submitted,

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